

REMARKSStatus of the Claims

Claims 1-20 are pending in the application. Claims 2, 3 and 9-20 have been canceled without prejudice. Claims 1 and 4 have been amended.

Election/Restriction

On page 3 of the office action the examiner sets forth the scope of the search without explaining how he arrived at this particular scope. Applicants have amended claim 1 to incorporate the limitations of original claim 3, and as a consequence, the scope of the amended claim 1 falls within the scope of the search except for R³ (which includes alkyl) and R⁷ (which includes hydrogen). Given that the scope of the search is established arbitrarily by the examiner, Applicants respectfully request the examiner reconsiders this aspect, and adopt the scope of amended claim 1.

Rejection under 35 U.S.C. 102

Claims 1-8 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Stetter et al. Applicants traverse in part as the rejection relates to claims 2 through 8. As the examiner will note, none of claims 2 - 8 read on Stetter et al; in claim 2 (and claims 3 and 4 depending thereon), R¹⁰ is not hydrogen, whereas Stetter et al require a hydrogen at the corresponding position; in claim 5, all the enumerated compounds also have a non-hydrogen at the R¹⁰ position. Claims 6 - 8 are directed to pharmaceutical compositions and their preparation; Stetter et al is a synthesis paper, and there is no teaching that compounds therein have pharmacological activities. Claim 1 has been amended to incorporate the limitations of claim 3, as discussed above, and now does not encompass any compound disclosed in Stetter et al.

The examiner also cites Kende et al, presumably against claims 1-8 as well. Applicants respectfully traverse. Kende et al disclose compounds in which at the position corresponding to R¹⁰, there is a -C(O)OR₂ group; however, in the instant claims, contrary to what the examiner states, C(=O)R^b is not a choice for R¹⁰, it is an optional substituent for the non-hydrogen choices for R¹⁰. Therefore, Kende et al is not anticipatory against any of the claims.

In view of the above, applicants respectfully submit that the 102(b) rejections are either improper or moot in view of the present amendment. Accordingly, applicants respectfully request the rejections be withdrawn.

Obviousness-Type Double Patenting


Claims 1-8 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-8 of US7087599 and also over claims 1-10 of US7157604. Applicants respectfully traverse.

The examiner will note that both the '599 and the '605 patents claim compounds having a 6-5-6 tricyclic ring system. The instant claims, as amended, are directed to compounds having 6-5-5, 6-5-7, 6-6-5 and 6-6-7 tricyclic ring systems. There is nothing in either the '599 or the '604 patent claims to suggest to a person of ordinary skill in the art to make the changes to arrive at the claimed invention. Applicants therefore believe the double patenting rejection is improper, and respectfully request its withdrawal.

Having addressed all of the outstanding objections and rejections, Applicants respectfully submit that the application is in condition for allowance and passage thereto is earnestly requested.

The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the application.

Respectfully submitted,

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Date: February 27, 2008